

REMARKS

The above amendment and these remarks are responsive to the Office Action of Examiner James A. Kramer, dated 28 July 2004.

Claims 1-17 are in the case, none as yet allowed.

35 U.S.C. 102

Claims 1, 4, 5, 6, 7, 10, 11, 14, 15, 16, and 17 have been rejected under 35 U.S.C. 102(e) over Maners.

The Examiner observes that by referring to "person" in the rejected claims, that limitation in applicant's claims may be read on a company as a requestor.

Applicants have amended all claims to clarify that it

is the individual that originally submitted a requisition, or created the original order, that must approve the resulting invoice.

Applicants invention relates to a method and system for invoice authorization by the original requester (that is, individual employee) with invoices presented to the requester in a particularly useful and user friendly manner whether such invoices are received hard copy or by EDI. These concepts are explained in applicants' specification, for example, at page 16, line 20 to page 19, line 10.

Maners U.S. Patent 6,507,826 B1 relates to EDI processing, which is automation between computer systems. Maners describes an "agent" that authorizes payment of invoices, but nowhere teaches that the "agent" must be the individual employee submitting the original requisition.

Applicants have amended these claims to clarify that their system and method provides for having the individual who created the original order make the determination that the resulting invoice from the vendor should be paid (or not). In applicants' invention, unlike Maners "agent", there is no centralization of payment authorization.

Applicants urge that claims 1, 4, 5, 6, 7, 10, 11, 14, 15, 16, and 17 be allowed.

35 U.S.C. 103

Claim 3 has been rejected under 35 U.S.C. 103(a) over Maners in view of Admitted Prior Art.

With respect to claim 3, applicants traverse the determination of the Examiner that the applicants have admitted that the conversion from electronic invoices received from a vendor into an image file having the look and feel of a paper invoice is well known or common knowledge. Applicants respectfully disagree with the Examiner that any facts currently alleged to be established by Official Notice and as admitted prior art are so established, since prosecution remains open. See, *In re Soli*, 317 F.2d 941, 137 USPQ 797, 800 (CCPA 1963) (record not fixed while response may be made to the Patent Office). In addition, in the previous amendment, applicants argued that the Maners reference had been distinguished with respect to its parent claim 1, which claim was amended to

clarify the distinctions, thereby rendering moot the Examiner's reliance on common knowledge, and thus traversing the rejection of claim 3 without admitting any prior art based on common knowledge. It was in the interest of brevity that Applicants only addressed so much of the rejection as is considered necessary to demonstrate the patentability of the claims. Applicants' choosing to not specifically address any part of the rejection should not be construed as an acquiescence in the propriety of such portions not addressed, including, but not limited to, the existence of facts alleged to be established by Official Notice.

Applicants now specifically traverse the Official notice relating to the feature specifically recited in claim 3, and kindly request the Examiner to provide a reference supporting such Official Notice for modification of the teachings of *Maners*. See, *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) ("[D]eficiencies of the cited references cannot be remedied by the [Office's] general conclusions about what is basic knowledge or common sense. The [Office's] findings must extend to all material facts and must be documented on the record, lest the haze of so-called expertise acquire insulation from accountability.

Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.") (Internal quotes and citation omitted).

The courts have held that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2D 981, 180 USPQ 580 (CCPA 1974). As illustrated above, Maners lacks any teaching or suggestion of certain recited claim features. Therefore, Applicants respectfully submit that the rejection over Maners has been obviated, and kindly request favorable reconsideration and withdrawal.

Claims 2, 8, 9, 12, and 13 have been rejected under 35 U.S.C. 103(a) over Maners in view of Cukor et al. (hereinafter Cukor).

Applicants traverse. Cukor describes the management and processing of shipping transactions via image processing. The workflow does not address any associated business workflow, such as payment or reconciliation of goods received. It does offer a detailed breakdown of how

imaging systems can reduce the large amount of paper (and error) usually associated with such processing. However, it does not describe any end-user decision points for paying for goods received, particularly on the claimed point that such decision is made by the original individual employee requester. This aspect of lack in Cukor's teachings reaches to the point that *prima facie* obviousness has not been established.

The courts have held that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 f.2D 981, 180 uspq 580 (ccpa 1974). As illustrated above, Maners lacks any teaching or suggestion of certain recited claim features, and these features are not provided by Cukor. Therefore, Applicants respectfully submit that the rejection over Maners in view of Cukor has been obviated, and kindly request favorable reconsideration and withdrawal.

The courts have held that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 f.2D 981, 180 uspq 580 (ccpa 1974). As

illustrated above, Maners and Cukor both lack any teaching or suggestion of certain recited claim features. Therefore, Applicants respectfully submit that the rejection has been obviated, and kindly request favorable reconsideration and withdrawal

Applicants request that claims 2-3, 8-9, and 12-13 be allowed.

SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-17.


The Application is believed to be in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in

condition for allowance without further proceedings being necessary.

Sincerely,

T. A. Aber, et al.

By


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Date: 25 Oct 2004

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